UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,242	01/16/2004	Bernd Sundermann	029310.53136US	5321

23911 7590 06/06/2006

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

EXAMINER	
DAVIS, BRIAN J	

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/758,242	SUNDERMANN ET AL.	
	Examiner	Art Unit	
	Brian J. Davis	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 125-161* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *151,152 and 157-161* is/are allowed.

6)☒ Claim(s) *1-11 and 125-150* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/4/06*.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *attached*.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

As is summarized in the attached Interview Summary form, applicant's first elected species was in error.

Applicant elected another species (3/30/06) with which this Office Action begins the Markush search. As a result of that search, vide infra, and in the interest of furthering prosecution, **non-elected Group III claims (claims 151-161) have been rejoined.**

Claim Rejections - 35 USC § 112, NEW

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The exact metes and bounds of the provisos at the end of the claim are unclear. The examiner respectfully suggests that the language and tabulation used on page 31 of the specification be incorporated into the proviso section of the instant claim in order to avoid any possible ambiguity.

Claims 153-156 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. There is no antecedent basis for the limitation RO6 (or R^{06}) in the claims.

Claims 2, 4, 6-11 and 125-149 are also rejected under 35 USC 112, second paragraph, as claims which depend from indefinite claims are also indefinite. *Ex parte Cordova*, 10 USPQ 2d 1949, 1952 (PTO Bd. App. 1989).

102 Rejections Withdrawn

The rejection of claims 1-11 and 125-150 under 35 USC 102(b), outlined in the previous Office Action, is withdrawn. As applicant states in the amendment, this first elected species was in error since this species is excluded by proviso. With specific respect to (method) claim 150 (which encompasses a broader set of compounds than compound claim 1), the cited art neither teaches nor suggests the instant method. The rejection was improper. The examiner regrets the error.

Double Patenting Rejections Withdrawn

The provisional rejection of claims 1-11 and 125-150 under 35 USC 101, outlined in the previous Office Action, is withdrawn. As applicant correctly points out, the rejection was improper. The examiner regrets the error. A new double patenting rejection follows.

Double Patenting, NEW

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 and 125-150 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-42 of copending Application No 10/758,241. Although the conflicting claims are not identical, they are not patentably distinct from each other because the set of compounds of 10/758,241 is a subset of the instant set. Case law seems clear on this point: The principle is well established in chemical cases, and in cases involving compositions of matter, that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining a patent to the "generic claim." *In re Steenbock*, 1936, C.D. 594, 473 O.G. 495.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

The 3/30/06 elected species has been searched and is deemed free of the prior art. The search was therefore expanded as called for under current Office Markush practice, a compound-by-compound search. This resulted in all remaining species being searched.

Claims 151, 152 and 157-161 are allowed. The remaining claims would also be allowable once the 112 and double patenting rejections outlined in this Office Action have been overcome. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art appears to be US 4,115,589 and US 4,366,172, both of which were cited by applicant in the IDS. The references both teach compounds (column 1 line 10 and column 1 line 15, respectively) that have been explicitly excluded by proviso from the set of compounds taught in instant claim 1. Neither reference teaches applicant's method (instant claim 150).

The cited prior art neither teaches nor suggests the instant compounds or methods. Nor would it have been obvious to one of ordinary skill in the art at the time of invention to modify the compounds/methods of the prior art in order to arrive at those of the instant invention. There is no motivation to do so.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian J. Davis
June 1, 2006